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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,210	06/24/2003	David B. Gricp	066042-9326-00	2237
60840	7590	09/12/2006	EXAMINER	
MICHAEL, BEST & FREIDRICH LLP 100 EAST WISCONSIN AVENUE SUITE 3300 MILWAUKEE, WI 53202			PETERSON, KENNETH E	
		ART UNIT	PAPER NUMBER	3724

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/602,210	GRIEP ET AL.
	Examiner Kenneth E. Peterson	Art Unit 3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 28 July 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 20-33,36,37,39-41,44-58 and 60-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 20-33,36,37,39-41,44-58 and 60-67 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7 Aug 06</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3724

1. Applicant's IDS, received 07 August 06, has been considered. However, due to the extraordinary number of references provided, Examiner was not able to apply his usual thorough analysis to each reference, due to time constraints. Each reference was considered only for what the cover figure conveyed upon brief viewing. There may very well have been missed information inside that is important to the patentability of this case.

Examiner suggests that Applicant select a dozen or fewer references, and Examiner will give them a more thorough review.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 20-28,30-33,36,37,39-41,44-49,51-56,58,60-63 and 65-67 are rejected under 35 U.S.C. 103(a).

It is old and well known for reciprocating saws to have all of the recited limitations except the elastic force transmitter. An example of this is the patent to Butz '685, and there are numerous other reciprocating saws that could be used in lieu of Butz for the purpose of this rejection.

Butz does not have an elastic force transmitter, but such is well known in the art of reciprocating saws, as shown by Palm '023 in figure 7. Palm shows an externally

toothed inner hub (710) and an internally toothed outer gear (716) having a plurality of elastic rubber elements positioned between the interacting teeth. Examiner notes that Palm's gear teeth and hub teeth do not radially overlap, but Applicant has not claimed this.

It would have been obvious to one of ordinary skill in the art to have modified Butz by providing his driven gear (40) with an elastically connected internal hub, as taught by Palm, in order to extend the life of the tool (Palm's lines 41-47, column 6). After this modification, Butz's elements 36,24 and 29 would be as one with the inner hub, and thus the inner hub would have an eccentric output member (29).

The following is seemingly unnecessary, but if there is any doubt about the obviousness of placing the elastic force transmitter between Butz's driven gear (40) and driven shaft (36), then attention is drawn to figure 2 of the patent to Knight '813, who shows selective force transmittal between the gear (116) and the output member (125).

To make clear the details and motivations for this combination, Examiner will analyze Butz's and Palm's drive chain via an item by item comparison.

Butz's drive includes;	Palm's drive includes;
Motor – 80	Motor – 16
Motor shaft – 42	Motor shaft – 18
Pinion – 41	Pinion – unnumbered, at end of shaft 18
Driven gear – 40	Driven gear – 716
	Hub with elastic drive transmitter – 710,722
Driven shaft – 36	Driven shaft – 226
Driven eccentric – 24,29	Driven eccentric – 18
Driven arm – 23	Driven arm – 30
Output member – 12	Output member – 40
Blade – 10	Blade – 42

Obviously, anyone of ordinary skill would realize the hub with the elastic drive transmitter would be a valuable addition to any reciprocating saw, in order to extend the life of the saw (Palm's lines 41-47, column 6). The question of where on Butz to add this feature also would have been obvious to one of ordinary skill. As seen in the table above, Palm teaches placing the hub and elastic drive transmitter between the driven gear and the driven shaft. Accordingly, one modifying Butz would also place the hub

and elastic drive transmitter between the driven gear (40) and the driven shaft (36).

Once this modification was made, Butz's new hub would be integral with the driven shaft (36), which in turn is integral with the driven eccentric (24,29), so the new hub would effectively have an offset drive member (29), just as set forth in Applicant's claims.

To be perfectly clear about the modification, Butz would no longer have a set screw (39) attaching the driven gear (40) to the driven shaft (36). Instead, Butz's driven gear (40) would have therein the hub (710) and elastic force transmitter (722), just like Palm's driven gear (716) has therein the hub and elastic force transmitter. Butz's new hub would be integral with the driven shaft (36), just like Palm's hub (710) is integral with his driven shaft (226).

4. Claims 20-33,36,37,39-41,44-58 and 60-67 are rejected under 35 U.S.C. 103(a).

The below specifically addresses claims 29,50,57 and 64, but is pertinent to all the claims that address the elastic force transmitter.

Butz, as modified above, has an elastic force transmitter that is not a body with a plurality of elastic protrusions thereon. However, such is well known as taught by King et al.'368 and/or Iwabuchi et al.'981. These two patents show the elastic force transmitter employed by the Applicant. Since both King (lines 34,35, column 1) and Iwabuchi (lines 21,22, column 1) are for the same purpose as Palm (preventing high impact load), they are considered to be art recognized equivalents known for the same purpose. It would have been obvious to one of ordinary skill in the art to have modified

Butz by employing the elastic force transmitters of King or Iwabuchi instead of the elastic force transmitter of Palm, since they are art recognized equivalents know for the same purpose.

5. Applicant's arguments have been fully considered but they are not persuasive.
Applicant's arguments have been addressed by clarifying the rejection above.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth E. Peterson whose telephone number is 571-272-4512. The examiner can normally be reached on Mon-Thur, 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

kp


KENNETH E. PETERSON
PRIMARY EXAMINER